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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,614	01/05/2004	Terrance W. Oliver	1482/132(d)	2429
32856	7590	11/02/2005	EXAMINER	
WEIDE & MILLER, LTD. 7251 W. LAKE MEAD BLVD. SUITE 530 LAS VEGAS, NV 89128				HESS, DANIEL A
		ART UNIT		PAPER NUMBER
		2876		

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/751,614	OLIVER, TERRANCE W.
	Examiner Daniel A. Hess	Art Unit 2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 September 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 21,23,24,26-28 and 30-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 21, 23, 24, 26-28, 30-40 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

This action is in response to applicant's arguments and amendments of 9/14/2005, which have been scanned into the electronic file of record.

### *Response to Arguments*

Applicant's arguments filed 9/14/2005 have been fully considered but they are not persuasive. Rendleman et al. (US 6,059,659), the primary reference applied in the first action in the instant case, teaches a gaming chip having a transponder that has a memory that includes (column 3, line 4) denomination value. The chip is able to thus identify itself among multiple different classes according to denomination value via its transponder.

**The examiner's position is that for the chips to have further distinguishing data represents merely an extension of the differentiation among classes that is already present in Rendleman et al., where different classes are casino chips having different denominational values.**

The examiner notes that structurally, the applicant's gaming chip would have little distinction from the chip of Rendleman et al. because the only difference lies in software programming of the memory on the respective gaming chips. And even this difference is only in the fact that Rendleman et al. defines one way of differentiating among multiple classes of chips while the instant Invention shows multiple ways of differentiating among different classes of chips. **Rendleman et al. already shows how to differentiate among gaming chips using a transponder system and memory. One would only need to duplicate this system to achieve**

**additional types of differentiation of gaming chips.** Busch et al. (US 6,059,659) provides motivation for having additional types of differentiation among gaming chips.

**The examiner notes that, importantly, the instant claims are apparatus claims and not method claims, so what matters are structural elements.** Rendleman et al. has the same basic structure as claimed in the instant invention, with the exception of certain differences in the data stored in memory. Otherwise the gaming chips are the same. This difference in memory is that the instant invention teaches additional categories of differentiation among gaming chips. This is easily remedied, using Rendleman et al.'s own teachings, repeated for additional categories of chip differentiation, and motivated by Busch et al.

As regards to specific arguments by the applicant, the examiner agrees with the applicant that a difference in what is stored on the memory of a gaming chip is a real difference. This is why Rendleman et al. was used in an obviousness-type rejection (35 USC 103) and not an anticipation-type rejection (35 USC 102). The examiner did in fact grant full weight to what is stored on the gaming chip. In pointing out that the modification would be in software (i.e. in memory), and that the software would be similar to software already present, the examiner was simply making the point that the modification would not be technically difficult, in order to bolster his case for obviousness.

The applicant's point that Busch, four years after Rendleman et al., does not incorporate Rendleman et al.'s technology is not convincing. By this logic, an obviousness type rejection

should not be made where the references are more than four years apart. Never have either the Office or the courts ever given credence to that type of logic, as far as the examiner is aware.

As for the contention that Busch is unrelated art, this is clearly untrue, since Busch is similarly concerned with gaming chips.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 21, 23, 24, 26-28, 30-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rendleman et al. (US 5,166,502) in view of Busch et al. (US 6,059,659).

Re claims 21, 23, 24, 26-28, 36, 37: Rendleman et al. teaches an electronic gaming chip (figure 5 ; column 1, lines 10-20; column 2, lines 60-65). There is a transponder with identifying information thereon (column 2, lines 62-64; column 3, lines 32-35). There is (column 2, line 61

to column 3, line 10) a 32 bit memory located on the transponder that includes (column 3, line 4) denominational value.

What Rendleman et al. fails to show is a second class of chip.

Busch et al. teaches (column 6, especially lines 1-10), “progressive chips” which are a separate category of chips. In at least one form (column 6, lines 20-30), these progressive / non-value chips are not the same as those used to place the standard bets.

In view of Busch et al.’s teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to accommodate Rendleman et al.’s chip technology to Busch’s “progressive chips” because that way the house can have an easier time managing many complex side-bets. Capability to distinguish among chips is already present, as evidenced by distinguishing among chips of different denominations. Simply adding to this the ability to distinguish among different types of chips involves only software and not hardware changes.

As to the limitation of intermingling various classes of chips in the same bet, the examiner notes that the need to keep progressive bets in a side pile is largely due to an inability to distinguish among chips, which is not a problem with electronic chips, which can easily be distinguished from one another. One would have been motivated to intermingle such various chips in the same bet to save table space, which is valuable when there are many players who wish to play.

Re claim 30: It is clear in Busch that in at least one embodiment the “progressive chips” appear distinct.

Re claims 31/32: In such electronic systems as that of Rendleman, et al. the playing area normally has readers to interact with the chips. See for example French (US 5,735,742, figure

3). Normally the use of any chip would be sensed by the table and this would include “progressive chips” as per the modification re claim 27. The table would know (fig. 3 of French) who placed the bet because each person has a position.

Re claims 33/34: Busch had noted that “progressive chips” can either have value or be valueless (column 6, lines 5-10). Any corresponding electronic chip would also have these two states.

Re claim 35: The promotional prize may be a jackpot, which is not a denomination, per se.

Re claim 38: The side bets (which is another term for what is happening with the “progressive chips” can be considered a bonus game occurring simultaneously.

Re claim 39: A side-bet jackpot can be considered a promotional prize for playing the game.

Re claim 40: In Busch et al., “progressive chips” may be separate from regular chips. The easiest way to do this is by making them distinct visually, which is a technically very easy step. The motive would be to keep people from becoming confused.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A. Hess whose telephone number is (571) 272-2392. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
DH

DANIEL STCYR  
PRIMARY EXAMINER